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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/596,567 | 06/19/2000 | Erwin Perry Comer | IR105248 | 3821 |

22863 7590 06/24/2004

MOTOROLA, INC.
CORPORATE LAW DEPARTMENT - #56-238
3102 NORTH 56TH STREET
PHOENIX, AZ 85018

EXAMINER

NGUYEN, JOSEPH D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2683

4

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,567

Applicant(s)

COMER ET AL.

Examiner

Joseph D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,738,902. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are broader than the ones in the patent. *In re Van Ornum and Stang*, 214, USPQ 761, 765 (CCPA 1982). In particular, the claims lack of generating the list of subscriber unit IDs based in part upon location data for each subscriber unit whose subscriber unit ID appears on the list and in part upon a boundary of a jurisdiction within which a communication intercept is authorized as specified in the patent.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnusson (6,122,499) in view of Ruppert et al. (6,738,902).

Regarding claim 1, Magnusson discloses a method of performing communications intercepts in a communications system comprising at least one satellite communications node and a plurality of subscriber units (abstract, fig. 1), the method comprising:

a) maintaining a database of subscriber unit identifiers and jurisdictional information associated with each of the plurality of subscriber units (abstract, #150 fig. 6, col. 6 lines 4-14, and col. 10 lines 4-36, col. 14 lines 34-46, and col. 15 lines 51-64);

b) selecting one of the plurality of subscriber units as a target subscriber unit (fig. 7, col. 13 lines 37-65); and

c) identifying the at least one satellite communications node associated with the jurisdictional information associated with the target subscriber unit (fig. 1, col. 1 lines 40-44, col. 2 line 64 thru col. 3 line 15, col. 10 lines 4-16, col. 14 lines 34-46, and col. 15 lines 51-64);

d) transmitting (sending or delivering) an intercept order comprising the identifier for the target subscriber unit to the identified at least one satellite communications node

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providing service to the target subscriber unit (fig. 1, col. 9 line 1 thru col. 10 lines 48);
and

e) receiving (acknowledgment) an intercepted communication with the target subscriber unit from the at least one satellite communications node (abstract, fig. 1, 4-5, col. 9 lines 1-18).

However, Magnusson does not specifically disclose identifying at least one satellite communications node associated with the jurisdictional information associated with the target subscriber unit.

Ruppert et al. teaches identifying at least one satellite communications node associated with the jurisdictional information associated with the target subscriber unit (col. 7 lines 17-32). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Magnusson system with the teaching of Ruppert et al. of identifying at least one satellite communication node in order to send the intercept request to the right jurisdictional where the target subscriber unit is located for faster executing of the request.

Regarding claim 2. Magnusson further discloses the method recited in claim 1 wherein the communications system further comprises a network management facility (#60, #62 fig. 1, col. 2 lines 20-36).

Regarding claim 3, Magnusson further discloses the method recited in claim 2 wherein the at least one communications node comprises a memory (database storing records of register) (abstract), the method further comprising:

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- the at least one satellite communications node storing the intercept order into an intercept table (list) in the memory (abstract, #150 fig. 1, col. 2 lines 30-37, and col. 15 lines 51-64).

Regarding claim 4, Magnusson further discloses the method recited in claim 3 wherein in the selecting operation more than one of the plurality of subscriber units (list of subscribers for selecting) is selected as a target subscriber unit (abstract, #12 fig. 7, col. 13 line 37 thru col. 14 line 2), wherein the selecting operation is performed by at least one intercept requestor having an intercept requestor ID (fig. 5 col. 9 line 1 thru col. 10 line 48), and wherein the intercept table comprises a list of all target subscriber units within the footprint of the at least one satellite communication node (fig. 1-3. col. 1 lines 56-65, col. 2 lines 30-37, and col. 9 lines 45 thru col. 10 lines 16), each target subscriber unit having associated there with at least one intercept requestor ID (fig. 3-7, col. 9 lines 1-18, and col. 10 lines 31-48).

Regarding claim 5, Magnusson further discloses the method recited in claim 2 wherein the identifier comprises an encrypted subscriber unit ID corresponding to the target subscriber unit (col. 15 lines 1-5).

Regarding claim 6, Magnusson further discloses the method recited in claim 5 and further comprising:

a) the at least one satellite communications node determining whether a received communication comprises the subscriber unit ID for the target subscriber unit (fig. 1, 3-4, col. 2 line 64 thru col. 3 line 15, col. 9 lines 1-18, and col. 11 line 61 thru col. 12 line 7);

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b) intercepting the communication when said at least one satellite communications node determines said communication comprises said subscriber unit ID (col. 1 lines 40-43, col. 3 lines 7-15, col. 10 lines 30-51, and col. 10 line 61 thru col. 12 lines 9); and

c) transmitting without intercepting the communication when said at least one satellite communications node determines said communication does not comprise said subscriber unit ID (when the subscriber is not on the intercepting list 140 the intercepting will not be performed) (col. 12 lines 1-20).

Regarding claim 7, Magnusson further discloses the method recited in claim 6 wherein the communications system further comprises a network intercept facility (#60, 62 fig. 1), and wherein the intercept order comprises a network intercept facility ID identifying the network intercept facility (col. 9 line 1 thru col. 10 line 48), the method further comprising:

if the at least one satellite communications node intercepts the communication, transmitting the communication to the network intercept facility (abstract, fig. 1, 4-5, and col. 1 lines 56-65, col. 7 lines 26-33, and col. 9 line 1 thru col. 10 line 3).

Regarding claim 8, Magnusson further discloses the method recited in claim 2 wherein the communications system further comprises a network intercept facility (#60, 62 fig. 1, fig. 4, and col. 9 lines 45-60), and wherein the intercept order comprises a network intercept facility ID identifying the network intercept facility (col. 9 line 1 thru col. 10 line 48), the method further comprising: the at least one satellite communications node transmitting the communication to the network intercept facility (abstract, fig. 1, 4-

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5, 7, col. 1 lines 56-65, col. 7 lines 26-33, and col. 9 line 1 thru col. 10 line 3). However, Magnusson does not specifically disclose wherein the intercept order comprises a network intercept facility ID identifying the network intercept facility. But it would have been obvious to one ordinary skilled in the art that the intercept order or request in Magnusson system would include the intercept facility ID identifying the network intercept facility in order to process the intercept request communication.

Regarding claim 9, Magnusson further discloses the method recited in claim 8 wherein the intercept order identifies an intercept requestor, the method further comprising: the network intercept facility addressing a transmission of the intercepted communication to the intercept requestor (fig. 4-5, col. 9 line 1 thru col. 10 line 48).

Regarding claim 10, Magnusson further discloses the method recited in claim 8 wherein the intercept order identifies an intercept requestor, the method further comprising: the network intercept facility providing a transmission of the intercepted communication to the intercept requestor (fig. 4-5).

Regarding claim 11, Magnusson discloses a satellite communications node for use in a communications system having a plurality of communications nodes (abstract, fig. 1), the satellite communications node comprising:

a) a transceiver (transmit/receive modules) to receive communications from one communications node (fig. 1, col. 1 lines 41-67) and to transmit communications to another communications node (fig. 1, col. 1 lines 41-67);

b) a data processing system (fig. 1, 5, col. 14 lines 24-67), including a processing element (col. 14 lines 24-33) and a memory (database) (#150 fig. 6, col. 14 lines 24-67),

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to execute at least one computer program performing intercepts in the communications system, the at least one computer program (col. 2 lines 50-60, col. 10 line 62 thru col. 11 line 28) when executed comprising the operations of:

- c) receiving an intercept order from a network intercept facility (col. 9 lines 1-50), the intercept order comprising a target communications node ID assigned by a network operations facility (col. 3 lines 7-15, and col. 9 line 1 thru col. 10 line 61);

- d) decrypting (unscrambles or deciphers) the intercept order to thereby verify the network intercept facility (col. 15 lines 1-5);

- e) separately decrypting the target communications node ID to thereby verify the network operations facility (col. 15 lines 1-5);

- f) evaluating a communication received by the transceiver to determine whether it comprises the target communications node ID (col. 3 lines 7-15, col. 9 lines 1-18, col. 10 lines 30-48, and col. 12 lines 1-23);

- if so, intercepting the communication (col. 7 lines 11-25); and

- if not, controlling the transceiver to transmit the communication without intercepting it (col. 3 lines 7-15, and col. 9 line 1 thru col. 10 line 61).

However, Magnusson does not specifically disclose the intercept order comprising a target communications node ID assigned by a network operations facility; and separately decrypting the target communications node ID to thereby verify the network operations facility; and evaluating a communication received by the transceiver to determine whether it comprises the target communications node ID: if so, intercepting

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the communication; and if not, controlling the transceiver to transmit the communication without intercepting it.

Ruppert et al. teaches a target communications node ID assigned by a network operations facility (fig. 3, 6, col. 8 lines 14-25); and separately decrypting the target communications node ID to thereby verify the network operations facility (fig. 6, col. 9 lines 1-10, col. 11 lines 22-28, and col. 12 lines 18-35); and evaluating a communication received by the transceiver to determine whether it comprises the target communications node ID (col. 8 lines 44 thru col. 10):

if so, intercepting the communication (fig. 7, col. 12 lines 39-67); and

if not, controlling the transceiver to transmit the communication without intercepting it (fig. 7, col. 12 lines 39-67). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Magnusson system with the teaching of Ruppert et al. of target communication node ID and separately decrypting the target communication node ID to verify the network operations facility, evaluating the order in order to execute the intercept request order with security and legal.

Regarding claim 12, Magnusson further discloses the satellite communications node recited in claim 11 wherein the intercept order is stored in an intercept table in the memory (abstract, col. 2 lines 20-60, col. 12 line 24 thru col. 13 line 46, and col. 15 lines 6).

Regarding claim 13, Magnusson further discloses the satellite communications node recited in claim 11 wherein the intercept order further comprises a start time when

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evaluating is to start, and wherein evaluating starts at the start time (col. 5 lines 26-47, col. 9 lines 19-33, and col. 12 lines 24-39). However, Magnusson does not specifically disclose a start time when evaluating is to start, and wherein evaluating starts at the start time. But it would have been obvious to one ordinary skilled in the art that the Magnusson system operating under the real time or near real time of each country can set a start time when evaluating is to start, and wherein evaluating starts at the start time.

Regarding claim 14, Magnusson further discloses the satellite communications node recited in claim 1 wherein the intercept order further comprises a stop time when evaluating is to stop, and wherein evaluating stops at the stop time (col. 5 lines 26-47, col. 9 lines 19-33, and col. 12 lines 24-39). However, Magnusson does not specifically disclose a start time when evaluating is to stop, and wherein evaluating stop at the stop time. But it would have been obvious to one ordinary skilled in the art that the Magnusson system operating under the real time or near real time of each country can set a stop time when evaluating is to stop, and wherein evaluating stop at the stop time.

Regarding claim 15, Magnusson further discloses the satellite communications node recited in claim 11 wherein the at least one computer program when executed comprises the additional operations of:

if the communication is intercepted, generating a communication clone (abstract, fig. 1-2, 4-5, col. 1 line 56 thru col. 2 line 60, and col. 10 lines 52-61); and

controlling the transceiver to transmit the communication clone to another of the communications nodes (back-up or a parallel process generated an Intercept record,

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containing call associated data, e.g., called and calling party numbers, time of call and so on, which is also transferred to the LEMF) (abstract, fig. 1-2, 4-5, col. 9 lines 19-26, col. 10 lines 52-61).

Regarding claim 16, Magnusson further discloses the satellite communications node recited in claim 15 wherein the intercept order further comprises an ID corresponding to the network intercept facility to which a communication clone is to be transmitted, and wherein the transceiver is controlled to transmit the communication clone to the network intercept facility (abstract, fig. 1-2, 4-5, col. 1 line 56 thru col. 2 line 60, and col. 9 line 1 thru col. 10 line 61). However, Magnusson does not specifically disclose the intercept order comprises an ID corresponding to the network intercept facility.

Ruppert et al. teaches the intercept order comprises an ID corresponding to the network intercept facility (col. 8 lines 14-25). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Magnusson system with the teaching of Ruppert et al. of network intercept facility ID in order to identify the jurisdictional the network intercept facility that performs the intercept order.

Regarding claim 17, Magnusson further discloses the satellite communications node recited in claim 16 wherein the intercept order further comprises a start time when evaluating is to start only when the user is started using the phone, wherein evaluating starts at the start time, and wherein the start time has a different granularity than a start time stored at the network intercept facility corresponding to the intercept order (col. 9

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line 11 thru col. 10 line 61, col. 11 line 61 thru col. 14 line 2). However, Magnusson does not specifically disclose the start time has a different granularity than a start time stored at network intercept facility. But, It would have been obvious to one ordinary skilled in the art that the start time can only start when the user starts using the phone not the start time stored which means the start time has a different granularity than a start time stored at the network intercept facility corresponding to the intercept order in order to keep track the interception time and to evaluating the exact location of the user as needed to notify the law enforcement.

Regarding claim 18, Magnusson further discloses the satellite communications node recited in claim 16 wherein the intercept order further comprises a start time when evaluating is to start (setting up time, wherein evaluating starts at the start time, and wherein the start time has a different granularity than a stop time stored at the network intercept facility corresponding to the intercept order (col. 5 lines 26-47, col. 9 line 11 thru col. 10 line 61, col. 11 line 61 thru col. 14 line 2). However, Magnusson does not specifically disclose the start time has a different granularity than a stop time stored at network intercept facility. However, It would have been obvious to one skilled in the art that the Magnusson system with time set-up function we can set the start and stop time with a different granularity.

Regarding claim 19, Magnusson further discloses the satellite communications node recited in claim 15 wherein the intercept order further comprises an ID corresponding to an intercept requestor to which a communication clone is to be transmitted, and wherein the transceiver is controlled to transmit the communication

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clone to the intercept requestor (abstract, fig. 1-2, 4-5, col. 1 line 51 thru col. 2 line 60, and col. 9 line 1 thru col. 10 line 61).

Regarding claim 20, Magnusson discloses a communications facility for use in a communications system comprising a plurality of communications nodes, including a plurality of subscriber nodes and at least one satellite communications node in which communications are intercepted (abstract, fig. 1), the communications facility comprising:

a) a transceiver (transmit/receive) to receive communications from one communications node and to transmit communications to another communications node (fig. 1, and 5, col. 1 lines 51-55);

b) a data processing system (fig. 1, 5, col. 14 lines 24-67), including a processing element and a memory (database) (fig. 1, 5-6, col. 14 lines 24-67), the processing element executing at least one computer program stored in the memory (abstract, col. 14 lines 24-67), the at least one computer program when executed comprising the operations of:

c) Receiving an encrypted identifier for a target node of the plurality of subscriber nodes from a database associated with a network operations facility responsible for a jurisdiction served by the communications system in which the target node is located (fig. 1, col. 9 lines 1-26, col. 10 lines 4-36, col. 11 lines 4-28, and col. 15 lines 1-16);

d) Forming an intercept order (intercept request) comprising the encrypted identifier, wherein the intercept order is encrypted with a key that identifies the communications facility (col. 9 lines 1-18, and col. 15 lines 1-5); and

e) transmitting the intercept order to the at least one satellite communications node providing service to the jurisdiction in which the target node is located (col. 9 lines 1 thru col. 10 line 9).

However, Magnusson does not specifically disclose receiving an encrypted identifier for a target node, and transmitting the intercept order is encrypted with a key that identifies the communications facility.

Ruppert et al. teaches receiving an encrypted identifier for a target node (abstract, fig. 6, col. 8 lines 44-49), and the intercept order is encrypted with a key that identifies the communications facility (#308 fig. 6). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Magnusson system with the teaching of Ruppert et al. of receiving an encrypted identifier for a target node, and transmitting the intercept order is encrypted with a key that identifies the communications facility in order to perform an intercept order with security.

Response to Arguments

5. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

a. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

(703) 305-9509 (for informal or draft communications, please label

"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA. Sixth floor (Receptionist).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Nguyen whose telephone number is (703) 605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph Nguyen



Jun. 21, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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